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EXAMINER

SHAH, AMEE A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,091

Applicant(s)

FERREIRA, PHILIP

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 10-24 are examined in this action, claims 1-9 being drawn to a non-elected invention (see below).

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a system for automating the reverse auction negotiations process between a consumer and a plurality of automobile dealers comprising a communications interface, logic to provide a list of available automobiles and specifications options, logic to provide the consumer a contract for the reverse auction services in response to the consumer selection of desired automobile and related features, acceptance of contract terms and provision of payment information, logic to receive consumer identification and payment information, set up an auction account number, add consumer to the existing database, identify nearest dealer, establish auction term and provide consumer with receipt, logic to invite identified dealers to submit bids in response to consumer's selection of automobile and related features, and logic to end the auction, compare bids, notify lowest dealer bid and consumer of results, classified in class 705, subclass 26.
- II. Claims 10-24, drawn to a method for automating the reverse auction negotiation service between a consumer and a plurality of automobile dealers comprising a consumer specifying a desired vehicle and related features, inviting new dealers to participate in submitting price quotes, creating a reverse auction database,

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notifying the lowest bidder at the end of the auction, and providing the consumer with a list of auction bids at the end of the auction term, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of invention I can be used to practice another and materially different process than that of invention II, such as a process including providing a list of available automobiles, providing a consumer with a contract for reverse auction services, receiving consumer identification and payment information, setting up an auction account number for the consumer transaction, and allowing non-invited dealers to request invitation to bid subject to the consumer's authorization, not required by the method of invention II.

Because these inventions are independent or distinct for the reasons given above, have recognized divergent subject matter, and require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Charles Thoeming on May 2, 2006, a provisional election was made with traverse to prosecute the invention of II, claims 10-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the references are cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(m) because they contain improper shading that does not aid in the understanding of the invention and will not reproduce properly. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 contains the limitation “obtain the consumer’s zip code distance from the dealer.” It is not possible to have a “zip code distance” as a zip code is a numerical identification of a certain geographical location and as such, cannot be measured. For purposes of this action only, the Examiner interprets this limitation as the distance based on the geographical area identified by the zip code. Because claims 14-19 are dependencies of claim 13, they inherit the same deficiency, are rejected on the same bases and interpreted in the same manner.

Claims 13-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “may” in claims 13, 17-20 and 22 is a relative term that renders the claim indefinite. The term “may” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The limitations of the dealers reviewing all active auction databases, obtaining consumer’s zip code distance, and so forth of

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claim 13 can be read in the alternative or negative, i.e. it is not understood whether all the limitations of the claims are necessary or not. For purposes of this action, the Examiner will interpret the claims in the alternate, i.e. may or may not. Because claims 14-16 and 21 are dependencies of claims 13 or 21, they inherit the same deficiencies, are subject to the same rejected and are interpreted in the same manner.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-14, 16-18, 20 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghouri et al., U.S. Pat. App. Pub. No. 2002/0082978 A1 (hereinafter referred to as "Ghouri et al.").

Referring to claim 10. Ghouri et al. discloses a method of automating the reverse auction negotiation service between a consumer and a plurality of automobile dealers in order to provide the consumer with the lowest price for a new or used automobile of the consumer's specification (*see* Abstract), the method comprising the computer implemented steps of:

- the consumer specifying a desired make, model, and related specifications of desired automobile from an automobile data base, confirming the service contract, and providing the consumer's zip code location (Figs. 2-5 and 8 and pages 4-5, ¶¶0052, 0053, 0057 and 0058 – note the zip code is included in the mailing address);
- inviting new automobile dealers from a dealer database matched to the consumer's desired make, model, and related specifications of desired automobile and the consumer's zip code location to participate in submitting new automobile price quotes in response thereto (page 5, ¶¶0066-0067);
- creating a reverse auction database for the particular consumer automobile selection including an auction term (Fig. 15 and pages 5-6, ¶¶0066-0068 and 0070 – note the reverse auction is the PriceWar);
- notifying the lowest bidder at the end of the auction term (Fig. 17 and page 17, ¶0068); and
- providing the consumer with the list of auction bids at the end of the auction term (Fig. 19 and page 6, ¶0072).

Referring to claim 11. Ghouri et al. further discloses the method of claim 10 wherein a consumer who is not a current member of the service is provided with means for secure service logon and service payment, access featured services, and added to the service consumer database (pages 4-5, ¶¶0057-0058).

Referring to claim 12. Ghouri et al. further discloses the method of claim 11 wherein the consumer is provided with a receipt for each particular reverse auction subscribed to within the service's reverse auction database (Fig. 22 and page 6, ¶¶0073-0074 – note the receipt is the acceptance page).

Referring to claim 13. Ghouri et al. further discloses the method of claim 10 wherein dealers within the dealer data base may review all active reverse auction databases for the participating consumers to identify the automobile and specifications selected, obtain the consumer's zip code distance from the dealer, obtain the present number of bids, obtain the current lowest bid, determine the amount of time remaining in the auction term, and, if not an invited dealer, request an invite to bid (Fig 17. and page 5-6, ¶¶0067-0069, 0077 and 0078 – note the present number of bids is the open bids, the current lowest bid is included in the bid history and the amount if time remaining is the auction term is the closing time).

Referring to claim 14. Ghouri et al. further discloses the method of claim 13 wherein the consumer is provided the option of accepting or rejecting any dealer not initially invited and

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requesting an invitation to bid (page 6, ¶0072 – note that the consumer is provided with the option of accepting or rejecting any dealer, whether or not initially invited).

Referring to claim 16. Ghouri et al. further discloses the method of claim 13 wherein only one bid per dealer is active during the term of the reverse auction (page 6, ¶0071 – note the maximum number can be set to one).

Referring to claim 17. Ghouri et al. further discloses the method of claim 13 wherein participating dealers may lower or maintain their current bid levels during the term of the reverse auction (pages 5 and 6, ¶¶0068 and 0080).

Referring to claim 18. Ghouri et al. further discloses the method of claim 13 wherein participating dealers may raise their current bid levels during the term of the reverse auction only by contacting a customer support representative of the service (page 6, ¶¶0077-0078 – note the customer service representative is the manager who can correct bidding mistakes which include raising bid price).

Referring to claim 20. Ghouri et al. further discloses the method of claim 10, wherein the consumer may review at any time during the term of the reverse auction the current bids, the bid history, invited dealers, the consumer's selected options, the time elapsed in the bid term, and related services (Fig. 19 and page 6, ¶0072).

Referring to claim 24. Ghouri et al. further discloses the method of claim 11 wherein the consumer member featured services include buying a pre-owned automobile, buying a used automobile, obtaining free price quotations on automobiles, obtaining the lowest pricing for a specified automobile, or trading-in the consumer's existing automobile in the transaction for a new, pre-owned, or used automobile (page 6, ¶0072 – note the services include obtaining free price quotations and the lowest pricing for a specified automobile).

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri et al. in view of Holden et al., U.S. Pat. App. Pub. No. 2001/0032175 A1 (hereinafter referred to as “Holden et al.”).

Referring to claim 15. Ghouri et al. discloses the method of claim 13, as discussed above, but does not disclose wherein any dealer participating agrees to a bidding agreement. Holden et al., in the same field of endeavor of electronic shopping, discloses a method for an electronic reverse auction including wherein any participating dealer agrees to a bidding agreement (pages 3-4, ¶0051 – note the dealer is the bidder). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of

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Ghouri et al. to include the teachings of Holden et al. to allow for the participating dealers agreeing to a bidding agreement. Doing so would allow help ensure that all bids are placed with the intention of honoring the price, increase the reliability and trustworthiness of the auction system, and increase customer satisfaction, as suggested by Holden et al. (page 4, ¶0051).

Referring to claim 19. Ghouri et al. discloses the method of claim 13 as discussed above, but does not disclose wherein the consumer may lengthen the reverse auction term only by contacting a customer support representative of the service. Holden et al., in the same field of endeavor of electronic shopping, discloses a method for an electronic reverse auction including wherein the consumer may lengthen the reverse auction term only by contacting a customer support representative of the service (pages 4 and 5, ¶¶0056, 0069-0071 – note that the customer support representative is the reviewer of confirmer through the review or confirmation process). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri et al. to include the teachings of Holden et al. to allow for the consumer may lengthen the reverse auction term only by contacting a customer support representative of the service. Doing so would allow help thwart “snipers” (i.e. initiators who wait until the last minute to bid in hopes of outbidding others), so that there is no disincentive to bid early, thereby increasing the fairness and reliability of the auction, as suggested by Holden et al. (page 5, ¶0069).

Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri et al. in view of Freeland, U.S. Pat. App. Pub. No. 2002/0169640 A1 (hereinafter referred to as “Freeland”).

Referring to claim 21. Ghouri et al. discloses the method of claim 20, as discussed above, but does not disclose wherein the related services include automobile insurance, automobile financing, consumer credit reports, and vehicle history reports. Freeland, in the same field of endeavor as electronic shopping, discloses a system for facilitating the transfer of titles property, such as vehicles, including wherein a buyer has access to and can review automobile insurance, automobile financing, consumer credit reports, and vehicle history reports (page 1, ¶0003). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri et al. to include the teachings of Freeland to allow for buyer to review automobile insurance, automobile financing, consumer credit reports, and vehicle history reports. Doing so would provide the buyer with more of the information and services electronically that in the past required a physical dealer, as suggested by Freeland (page 1, ¶0003).

Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri et al. in view of Chaves, U.S. Pat. App. Pub. No. 2002/0042752 A1 (hereinafter referred to as “Chaves”).

Referring to claim 22. Ghouri et al. discloses the method of claim 10, as discussed above, but does not disclose wherein the consumer may trade in an existing automobile as part of the specification information provided to participating dealers. Chaves, in the same field of

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endeavor of electronic shopping, discloses a method and system for selling motor vehicles over the Internet including wherein the consumer may trade in an existing automobile as part of the specification information provided to participating dealers (pages 1-3, ¶¶0010, 0027, 0037, 0039 and 0054). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri et al. to include the teachings of Chaves to allow for the consumer to trade in an existing automobile as part of the specification information provided to participating dealers. Doing so would provide a more fully functional, remote, electronic method for dealers to better service and sell to their customers which in the past required a physical dealer, as suggested by Chaves (page 1, ¶0001).

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ghouri et al. in view of Gologorsky et al., U.S. Pat. App. Pub. No. 2004/0186805 A1 (hereinafter referred to as "Gologorsky").

Referring to claim 23. Ghouri et al. discloses the method of claim 10, as discussed above, wherein participating dealers provide quotes above, at, or below invoice or the manufacturer's suggested retail price, but does not disclose wherein the quotes are based upon a whole dollar amount. Gologorsky et al., in the same field of endeavor of electronic shopping, discloses a method of conducting auctions including wherein quotes are based upon a whole dollar amount (page 7, ¶0165). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Ghouri et al. to include the teachings of Gologorsky et al. to allow for quotes to be based upon whole dollar amounts. Doing

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so would provide a more efficient auction process by not littering the bids with trivial differences in quotes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Berent et al., U.S. Pat. No. 6,006,201, discloses an electronic auction and information system for remote selling and purchasing of motor vehicles (*see* entire document).

(2) Carlton-Foss, U.S. Pat. No. 6,647,373 B1, discloses a system for conducting an electronic reverse auction (*see* entire document).

(3) Nakai et al., JP 2003 196507A, discloses a system for conducting a reverse auction over the Internet for motor vehicles (*see* Abstract).

(4) Author unknown, "RevAuto.com Turns Online Car Buying Upside Down!" PR Newswire, New York, Dec. 15, 200, pg. 1, discloses a website for conducting reverse auctions on new automobiles.

(5) Author unknown, "USATradein.com Launches First Web Site Facilitating Online Automobile Trade-ins," PR Newswire, New York, Oct. 2, 2000, pg. 1, discloses a web site for conducting reverse auctions on used automobiles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh Garg can be reached on 571-272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

May 4, 2006


Y. C. Garg
Primary Ex.